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Edward J. Shoen

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EXAMINER

SALLIARD, SHANNON S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/087,193	Applicant(s) SHOEN ET AL.	
	Examiner SHANNON S. SALIARD	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5 and 26-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-25, and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 June 2008 has been entered.

Status of Claims

2. Applicant has amended claims 11 and 19 and cancelled claim 4. Claims 3, 5, and 26-29 have been withdrawn. Thus, claims 1, 2, 6-25, and 30 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments filed 13 June 2008 have been fully considered but they are not persuasive.

4. Applicant argues, "The subject recitations are structural, not functional." Examiner disagrees. The claimed "inventory information capture" and "customer information capture" are described as software within the specification. For example, on page 8, the Applicant states, "a user can login to the system using a secure login capture 12." As indicated in Figure 1, element 12 is an interface. An interface is

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considered to be software. Further Applicant's specification states, "For example, the automated self-storage system enables the user to view an inventory menu for a specified facility, and to manage room inventory by adding or removing rooms, changing the room size or description, or indicating whether a room is damaged" [0030]. An interface and menu are both considered to be software.

5. Applicant's arguments, with respect to the rejection(s) of claim(s) 2 and 31 under 35 U.S.C. 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gale et al [US 2001/0025250].

6. Applicant further argues (with respect to claim 1), "As discussed above, at the very least, the McCarty system does not expressly or inherently include cash summaries, reservations, open contracts or rent rolls." Examiner submits McCarty et al does not explicitly disclose the reports including reports for revenue, unit availability, reservations, open contracts, rent rolls, and credit card information. However, the difference between reports and reports for revenue, unit availability, reservations, open contracts, rent rolls, and credit card information are only found in the non-functional data contained within the report. The reports contain information which qualify as "descriptive material" since it is directed to the content of data, not structure, or an action or step. Further, the "reporting means" generate the reports, however, the reports will be generated the same regardless of what data is contained within the report. Therefore, the system has not changed and as such the specific interpretation of the reports generated by the reporting feature does patentably distinguish the

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claimed invention, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to provide any type of report in the system taught by McCarty et al because the subjective interpretation of the reports does not patentably distinguish the claimed invention.

7. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments with respect to claim 19 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's arguments with respect to claim 11 have been fully considered but they are not persuasive. Vasquez shows that transferring from one rental unit to another was known in the prior art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to have transferred a user from one rental unit to another by including a transfer means as in Vasquez in the system executing the method of McCarty. As in Vasquez, it is within the capabilities of one of ordinary skill in the art to install associated software for transferring to McCarty's personal computer with the predicted result of meeting the customer's satisfaction requirements as need in McCarty.

Drawings

10. The drawings are objected to because portions of the drawings are informal and drawn by hand. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

11. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When

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claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 31 been renumbered 30.

12. Claim 30 is objected to because of the following informality: The term “form” should be changed to “from” in line 6 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 1, 2, 6-9, 13-20, and 31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claims 1, 2, and 31**, the preamble of the claim anticipates a system; however, the limitations in the claim are functional rather than structural. In particular, the claimed “inventory information capture” and “customer information capture” are described as software within the specification. For example, on page 8, the Applicant states, “a user can login to the system using a secure login capture 12.” As indicated in Figure 1, element 12 is an interface. An interface is considered to be software. Further Applicant’s specification states, “For example, the automated self-storage system enables the user to view an inventory menu for a specified facility, and to manage room inventory by adding or removing rooms, changing the room size or description, or

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indicating whether a room is damaged" [0030]. An interface and menu are both considered to be software.

Additionally, the limitation "an inventory information capture having information pertaining to self-storage units in one or more self-storage facilities" as written is vague and indefinite. It is unclear to the Examiner whether the inventory information capture is utilized to input information relating to self-storage units in one or more self-storage facilities or the inventory information capture is where information, relating to self-storage units, that was previously collected has been stored. For the purpose of examination, the Examiner will interpret the customer information capture as an interface. A similar analysis takes place for the claimed "customer information capture", and as such the customer information capture will also be interpreted to be an interface.

Further, it is unclear whether the claimed "reporting feature" is structural or functional. As defined a "feature" is a characteristic or property of a device or software application computer process or an intended behavior of a computer program, and as such will not be considered a structural limitation. Since a feature is a behavior, it should be followed by an action. For example, "a feature producing" or "a feature generates". The claim, it states, "a feature includes means for generating reports". It is unclear whether the feature is the means or if there is some other means. It is further unclear whether the Applicant is intending to invoke 112, Sixth Paragraph. If invoking 112, Sixth Paragraph, the means must be identified within the specification. In this case, there are no means indicated for generating a report.

Additionally, the limitation "an inventory information capture having information pertaining to self-storage units in one or more self-storage facilities" as written is vague and indefinite. It is unclear to the Examiner whether the inventory information capture is utilized to input information relating to self-storage units in one or more self-storage facilities or the inventory information capture is where information, relating to self-storage units, that was previously collected has been stored. For the purpose of examination, the Examiner will interpret the customer information capture as an interface. A similar analysis takes place for the claimed "customer information capture", and as such the customer information capture will also be interpreted to be an interface.

Moreover, the limitation "wherein the reporting feature includes means for generating reports for managing the operation of the storage facility, including reports for revenue, unit availability, reservations, open contracts, rent rolls and credit card information" as recited is vague and indefinite. It is unclear to the Examiner how reports that contain information for revenue, unit availability, reservations, open contracts, rent rolls and credit card information are generated from **only** information that received from the customer information capture and the inventory information capture. Thus, it appears that a connection is missing between the information that was captured and the information that is output in the reports.

As per **claims 6-9**, the limitation "customer information capture" as recited is vague and indefinite as per the discussion above regarding claim 1. Appropriate correction is required.

As per **claims 13, 14, and 17-19**, the limitation “the reporting feature includes an audit report, a cash intake report, a receipt, a vacancy report, or facility utilization report” as recited is vague and indefinite. As discussed above with regards to claim 1, a feature is a property or behavior of a computer program. It is unclear how a reporting feature includes a report. Appropriate correction is required.

As per **claim 15**, the limitation “the reporting feature comprises data configured to be exported...” as recited is vague and indefinite. As discussed above with regards to claim 1, a feature is a property or behavior of a computer program. It is unclear how a feature comprises data. Appropriate correction is required

As per **claim 16**, the limitation “inventory information capture” as recited is vague and indefinite as per the discussion above regarding claim 1. Appropriate correction is required.

As per **claim 20**, the limitation “communication feature” as recited is vague and indefinite as per the discussion above of claim 1 with regard to a "reporting feature". Appropriate correction is required.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. **Claims 1, 2, 6-25, and 31** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 6-25, and 31 purport to be directed toward a system, however, the bodies of the claims recite only logic or software (i.e., interface) for a computer. Thus, the claims are directed to functional descriptive material that is not functionally or structurally interrelated to any medium. Data structures not claimed as embodied on statutory computer readable media (i.e., storage media, and excluding non-statutory media such as carrier waves) are descriptive material *per se* and therefore not patentable subject matter under § 101 as they are neither a process, a machine, a manufacture, nor a composition of matter. MPEP § 2106 IV.(g)(1)(a).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1, 17, and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660].

As per **claim 1**, McCarty et al discloses an automated self-storage management system for enabling a user to conduct self-storage transactions [Abstract], the system comprising:

an inventory information capture having information pertaining to self-storage units in one or more self-storage facilities [col 11, lines 27-35; management utility program for adding and removing storage facilities];

a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6]; and

a reporting feature in communication with the inventory information capture and the customer information capture, wherein the reporting feature includes means for generating reports for managing the operation of the storage facility [col 11, lines 32-35].

McCarty et al does not explicitly disclose the reports including reports for revenue, unit availability, reservations, open contracts, rent rolls, and credit card information. However, the difference between reports and reports for revenue, unit availability, reservations, open contracts, rent rolls, and credit card information are only found in the non-functional data contained within the report. The reports contain information which qualify as "descriptive material" since it is directed to the content of data, not structure, or an action or step. Further, the "reporting means" generate the reports, however, the reports will be generated the same regardless of what data is contained within the report. Therefore, the system has not changed and as such the specific interpretation of the reports generated by the reporting feature does patentably distinguish the claimed invention, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would also have been

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obvious to a person of ordinary skill in the art at the time of applicant's invention to provide any type of report in the system taught by McCarty et al because the subjective interpretation of the reports does not patentably distinguish the claimed invention.

As per **claim 17**, McCarty et al further discloses wherein the reporting feature comprises a receipt for self-storage transactions [col 6, lines 37-42].

As per **claim 31**, McCarty et al discloses an automated self-storage management system for enabling a user to conduct self-storage transactions [Abstract], the system comprising:

an inventory information capture having information pertaining to self-storage units [col 11, lines 27-35; management utility program for adding and removing storage facilities];

a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6];

a rental transaction feature configured to create a rental agreement using information from the inventory information capture and the customer information capture, wherein the rental agreement involves a plurality of self-storage units [col 6, lines 37-42; col 5, lines 56-62; col 8, lines 11-27; Fig. 6], and

a reporting feature in communication with the inventory information capture and the customer information wherein the reporting feature includes means for generating reports for managing the operation of the storage facility [col 11, lines 32-35].

McCarty et al does not explicitly disclose the reports including reports for revenue, unit availability, reservations, open contracts, rent rolls, and credit card

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information. However, the difference between reports and reports for revenue, unit availability, reservations, open contracts, rent rolls, and credit card information are only found in the non-functional data contained within the report. The reports contain information which qualify as "descriptive material" since it is directed to the content of data, not structure, or an action or step. Further, the "reporting means" generate the reports, however, the reports will be generated the same regardless of what data is contained within the report. Therefore, the system has not changed and as such the specific interpretation of the reports generated by the reporting feature does patentably distinguish the claimed invention, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to provide any type of report in the system taught by McCarty et al because the subjective interpretation of the reports does not patentably distinguish the claimed invention.

19. **Claims 2, 6, 9, 10, 14, 16, 18, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Gale et al [US 2001/0025250].

As per **claim 2**, McCarty et al discloses an automated self-storage management system for enabling a user to conduct self-storage transactions [Abstract], the system comprising:

an inventory information capture having information pertaining to self-storage units in one or more storage facilities [col 11, lines 27-35; management utility program for adding and removing storage facilities];

a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6];

wherein one or both of the inventory information capture and customer information capture include information for managing the operation of the self-storage facilities [col 11, lines 28-35; col 5, lines 10-12] including information on facility utilization [col 11, lines 32-35], unit availability [col 8, lines 1-5], reservations [col 7, lines 61-65], and credit card information [col 8, lines 10-12]; and

a rental transaction feature in communication with the inventory information capture and customer information capture, wherein the rental transaction feature creates a rental agreement using information from the inventory information capture and the customer information capture, and wherein the rental agreement involves a plurality of self-storage units [col 6, lines 37-42; Col 5, lines 56-62; col 8, lines 11-27; Fig. 6].

McCarty et al does not explicitly disclose the information including cash summaries, open contracts, and rent rolls. However, Gale et al discloses generating information on cash summaries [0126], open contracts [0123], and rent rolls [0125]. While Gale does not explicitly disclose that the information was captured, the information had to be collected in order to generate the associated reports. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty the ability to capture information on cash summaries, open

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contracts, and rent rolls as taught by Gale et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 6**, McCarty et al further discloses wherein the customer information capture includes an authorized access identifier [col 8, lines 15-17].

As per **claim 9**, McCarty et al further discloses wherein the customer information capture includes a credit card identifier [col 8, lines 8-11; col 5, lines 10-12].

As per **claim 10**, McCarty et al further discloses wherein the plurality of storage units comprises a first storage unit and a second storage unit [col 8, lines 1-3], an automatic payment feature applied to the first storage unit [col 8, lines 6-12] and an invoicing feature applied to the second storage unit [col 11, lines 15-28].

As per **claim 14**, McCarty et al does not disclose wherein the reporting feature includes a cash intake report. However, Gale et al discloses a storage rental system that generates a cash intake report [0117; 0126]. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty et al the ability to generate an cash intake report as taught by Gale et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 16**, McCarty et al further discloses wherein the inventory information capture comprises a map [col 9, lines 55-56].

As per **claim 18**, McCarty et al does not disclose wherein the reporting feature comprises a vacancy report. However, Gale et al discloses a storage rental system that generates a vacancy report [0128]. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty et al the ability to generate an vacancy report as taught by Gale et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 20**, McCarty et al further discloses comprising a communication feature configured to allow communication between users [col 4, lines 21-45].

20. **Claims 7, 8, 21, 22, and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Gale et al [US 2001/0025250] as applied to claim 2 above, and further in view of Hafen et al [US 2003/0023453].

As per **claim 7**, McCarty et al does not explicitly disclose wherein the customer information capture includes an emergency contact identifier. However, Hafen et al discloses collecting contact information from a customer [0098; 0099]. Although, Hafen does not explicitly disclose that the contact information is for an emergency it is obvious that since the customer is the user of the storage facility, if something of an emergency nature were to occur, the contact information of that customer would be used to notify the customer. Therefore, it would have been obvious to one of ordinary skill in the art at

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the time of the invention to modify the invention of McCarty et al to include wherein the customer information capture includes an emergency contact identifier to facilitate retrieval of pertinent information.

As per **claim 8**, McCarty et al does not disclose wherein the customer information capture includes a payment history. However, Hafen et al discloses collecting records regarding payment history [0098]. It would have been obvious to one of ordinary skill in the art to include in the self-storage system of McCarty et al the ability to collect payment history as taught by Hafen et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 21**, McCarty et al does not disclose further comprising a letter generation feature. However, Hafen et al discloses generating delinquency notices [0104; 0105]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include the method disclosed by Hafen et al so that a customer is made aware that their account is delinquent.

As per **claim 22**, McCarty et al does not disclose wherein upon occurrence of a predetermined criteria, the system generates a customer letter. However, Hafen et al discloses that a delinquent notice is sent according to a schedule [0104]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

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modify the invention of McCarty et al to include the method disclosed by Hafen et al so that a customer is made aware that their account is delinquent.

As per **claim 24**, McCarty et al does not disclose wherein the letter pertains to a rate increase. However, Hafen et al discloses generating a notice pertaining to a rate increase [0097]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include the method disclosed by Hafen et al. Hafen et al provides the motivation that a letter pertaining to a rate increased may be required due to local laws [0097].

21. **Claims 11 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Gale et al [US 2001/0025250] and Hafen et al [US 2003/0023453] as applied to claims 2 and 22 above, and further in view of Vasquez et al [article entitled Housing Crunch...Leave Area] .

As per **claim 11**, McCarty et al does not disclose comprising a transfer feature that transfers a customer from an occupied self-storage unit to a vacant self-storage unit. However, Vasquez et al discloses transferring a customer from an occupied apartment (i.e., rental unit) to a vacant apartment [pg. 1, para. 3]. Vasquez shows that transferring from one rental unit to another was known in the prior art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to have transferred a user from one rental unit to another by including a transfer means as in Vasquez in the system executing the method of McCarty. As in Vasquez, it is within the capabilities of one of ordinary skill in the art to install associated

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software for transferring to McCarty' personal computer with the predicted result of meeting the customer's satisfaction requirements as need in McCarty.

22. **Claim 12** rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Hafen et al [US 2003/0023453] as applied to claim 11 above, and further in view of Official Notice and Inomata [US 6,999,825].

As per **claim 12**, McCarty et al does not disclose comprising a fee calculator that calculates a prorated rent for the occupied room and a prorated rent for the vacant room. However, Inomata discloses a fee calculator for rental of a storage unit [col 13, lines 19-26]. Furthermore, the Examiner takes Official Notice that it is old and well known in the rental industry at the time of the invention to pay only for the time in which you occupy a room. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include comprising a fee calculator that calculates a prorated rent for the occupied room and a prorated rent for the vacant room so that a user is not overcharged.

23. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Taylor [US 2002/0010601].

As per **claim 13**, McCarty et al does not disclose wherein the reporting feature includes an audit report. However, Taylor discloses a method of renting a unit wherein an audit report is generated [0043]. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty et al the ability to generate an

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audit report as taught by Taylor since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

24. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Gross [US 6,721,716].

As per **claim 15**, McCarty et al does not disclose wherein the reporting feature comprises data configured to be exported to an external financial database. However, Gross discloses exporting financial data from rental transactions [col 22, lines 21-27]. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty et al the ability to export data to an external financial database as taught by Gross since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

25. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Brady [US 2004/0088318].

As per **claim 19**, McCarty et al further discloses wherein the reporting feature comprises a facility utilization report [col 11, lines 33-35]. McCarty et al does not disclose a facility utilization report including facility revenue and occupancy information for evaluating the effect of a rental rate change on facility revenue. However, Brady discloses a unit rental system which generates a report including facility revenue and occupancy information [0108]. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty et al the ability to export data to an external financial database as taught by Gross since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Further, the recited statement of intended use, for evaluating the effect of a rental rate change on facility revenue, does not patentably distinguish the claimed invention. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987).

26. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Gale et al [US 2001/0025250] and Hafen et al [US 2003/0023453] as applied to claim 22 above, and further in view of Official Notice.

As per **claim 23**, McCarty et al does not disclose wherein the letter pertains to an overdue fee. However, Hafen et al discloses that a delinquent notice is sent according

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to a schedule [0104]. Furthermore, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention that a delinquency notice contains an overdue fee. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the letter pertains to an overdue fee so that the user is aware of how much he/she is responsible for paying.

27. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Gale et al [US 2001/0025250] and Hafen et al [US 2003/0023453] as applied to claim 22 above, and further in view of Petkovsek [US 2002/0111923].

As per **claim 25**, McCarty et al does not disclose wherein the letter pertains to an eviction. However, Petkovsek discloses generating a letter that pertains to an eviction from a rental unit [0047]. It would have been obvious to one of ordinary skill in the art to include in the storage rental system of McCarty et al the ability to generate a letter pertaining to an eviction as taught by Petkovsek since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Shannon S Saliard
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Art Unit 3628

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